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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,727	07/26/2001	Ralph J. Locke	CNI-100-C	8203

7590 02/12/2003
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EXAMINER

FULLER, ERIC B

ART UNIT	PAPER NUMBER
1762	9

DATE MAILED: 02/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.
09/915,727

Applicant(s)
LOCKE ET AL.

Examiner
Eric B Fuller

Art Unit
1762

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 January 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) The period for reply expires 3 months from the mailing date of the final rejection.
- b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

- 1. A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
- 2. The proposed amendment(s) will not be entered because:
 - (a) they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) they raise the issue of new matter (see Note below);
 - (c) they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

- 3. Applicant's reply has overcome the following rejection(s): _____.
- 4. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
- 5. The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached Office Action.
- 6. The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
- 7. For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-11 and 13-32.

Claim(s) withdrawn from consideration: _____.

- 8. The proposed drawing correction filed on _____ is a) approved or b) disapproved by the Examiner.
- 9. Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
- 10. Other: _____

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DETAILED ACTION***Information Disclosure Statement***

The information disclosure statement filed December 9, 2002 fails to comply with 37 CFR 1.97(d) because it lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered.

Response to Arguments

Applicant argues that the composition of the present invention is used for attenuating noise, harshness, and vibration, whereas the composition of Primeaux is used for abrasion and impact resistance. Applicant alleges that the present invention is patentable because it recognizes a new use. Examiner disagrees.

In response, Examiner notes that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The claimed invention does not meet these requirements.

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Additionally, it is noted that the limitations of the claims are clearly drawn to a method of coating. The only "use" to speak of is in the preamble of the claims, where it is stated "a method for damping vibration of a substrate comprising the steps of". The process steps in the limitations are not steps for damping vibration; they are steps for putting a coating on a substrate where the coating has damping properties. Therefore, the recitation of "use" has not been given patentable weight because the recitation only occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Primeaux clearly teaches the limitations of the claims. A substrate is provided and a coating is applied that is the same as the applicant's. Since the coating is the same, the damping properties must be inherent. The only limitation not explicitly taught by the reference is that the coating is applied in a manner that produces a tight, well-defined application pattern, which has been shown to be obvious by the Examiner.

Applicant argues that Primeaux does not teach a tight, well-defined pattern of coating and alleges that an assertion that such knowledge would have been possessed by one of ordinary skill in the art is bare and unsubstantiated. This argument is unconvincing.

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It is noted that the specification does not give light to what degree of tightness or definition is required to read upon the applicant's claim. The only support is given in paragraph [0075], which only requires that the tightness and definition are "adequate" enough to achieve the coatings intended properties. The coating in Primeaux is used for impact resistance. For Primeaux to be enabled, the coating must be applied in a manner that is at least tight enough such that impact resistance is achieved. Thus, "tight" is read upon. The only assertion made is in "well-defined". To apply the coating where impact resistance is needed and not to areas where resistance is not needed reads on "well-defined". This knowledge is certainly possessed by one of ordinary skill in the art.

Therefore, the applicant's arguments have been considered, but are not found convincing. Examiner maintains the rejections of the previous Office Action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B Fuller whose telephone number is (703) 308-6544. The examiner can normally be reached on Mondays through Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck, can be reached at (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



EBF
February 8, 2003



SHRIVE P. BECK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700